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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/713,098 11/14/00 ZLOT

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028008  
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HM12/0719

EXAMINER

VANDER VEGT, F

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

07/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/713,098

Applicant(s)

Zlot et al

Examiner

F. Pierre VanderVegt

Art Unit

1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

This application claims priority to provisional application 60/165,438.

Claims 1-20 are currently pending in this application.

5                   **Please Note:** In an effort to enhance communication with our customers and  
reduce processing time, Group 1640 is running a Fax Response Pilot for Written  
Restriction Requirements. A dedicated Fax machine is in place to receive your  
10                   responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to  
this Office Action for your convenience. We encourage your participation in this  
Pilot program. If you have any questions or suggestions please contact Paula  
Hutzell, Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-  
4310. Thank you in advance for allowing us to enhance our customer service.  
Please limit the use of this dedicated Fax number to responses to Written  
15                   Restrictions.

### *Election/Restrictions*

1.     Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I.     Claims 1-10, drawn to a polynucleotide encoding DC-STAMP and DSP-1  
20                   fragments, vectors and cell lines comprising same and recombinant production of  
protein, classified in class 536, subclass 23.5; class 435, subclasses 320.1, 325  
and 71.1, respectively.
  - II.    Claims 11-15, drawn to DC-STAMP and DSP-1 binding compound comprising an  
25                   antibody binding site, classified in class 530, subclass 387.1.
  - III.   Claims 16-18, drawn to DC-STAMP and DSP-1 polypeptides, classified in  
class 530, subclass 350.
  - IV.    Claims 19-20, drawn to a method of affecting cell physiology with DC-STAMP or  
30                   DSP-1 agonists or antagonists, classified in class 435, subclass 375.

2.     The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they  
are not disclosed as capable of use together, or they have different modes of operation, or they  
35                   have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In  
the instant case the different inventions are three distinct classes of compound, nucleic acid,

protein product and antibody, which are biochemically distinct from one another and have different modes of action. Further, the protein can be made without recourse to the nucleic acid by the materially distinct process of biochemical purification from natural sources and the nucleic acid has separate utility as a probe for screening libraries. The protein can be made without  
5 recourse to the antibody by the materially distinct process of biochemical purification from natural sources and the antibody can cross react with other proteins. The nucleic acid is not required to make the antibody which may be raised against protein made without recombinant means and the nucleic acid has separate utility as a probe, for example. Further, the prior art has often identified proteins before the encoding nucleic acid has been identified, for example, via activity of the  
10 protein in an extract followed by purification or by preparation of mAbs against cells/lysates. Thus, a prior art reference teaching one of the products of Groups I-III need not teach the others.

Inventions I-III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different  
15 inventions are not related because the claims are drawn to affecting DC-STAMP and DSP-1 functionality in cells which naturally express said proteins and the recombinant cells of Group I and the purified polypeptides of Group III are therefore not required for the practice of the method of Group IV. Further, the binding compounds of Group II have separate utility from the method of Group IV in that they can be used for diagnostic/detection or for protein purification  
20 from a cell population or biological sample.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

25 4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

6. Papers related to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for official documents to be entered into the record for Art Unit 1644 is (703)305-3014.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to F. Pierre VanderVegt, whose telephone number is (703)305-6997. The Examiner can normally be reached Tuesday through Friday and odd-numbered Mondays (on year 2001 365-day calender) from 6:30 am to 4:00 pm ET. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ms. Christina Chan can be reached at (703)308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist, whose telephone number is (703)308-0196.

F. Pierre VanderVegt, Ph.D.  
Patent Examiner  
Technology Center 1600  
July 18, 2001



**F. PIERRE VANDERVEGT  
PATENT EXAMINER**